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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,045	03/01/2006	Takemori Takayama	20060-0165A	1859
513 7590 09/03/2009 WENDEROTH, LIND & PONACK, L.L.P. 1030 15th Street, N.W., Suite 400 East Washington, DC 20005-1503				
EXAMINER				
GARCIA, ERNESTO				
ART UNIT		PAPER NUMBER		
3679				
MAIL DATE		DELIVERY MODE		
09/03/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/570,045

**Applicant(s)**

TAKAYAMA ET AL.

**Examiner**

ERNESTO GARCIA

**Art Unit**

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-56 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Restriction and Election of Species***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-5 and 29-40, drawn to a sintered sliding material.

Group II, claims 6-12, 17-20, and 41-56, drawn to a sliding member.

Group III, claims 21-28, drawn to a connecting device.

Group IV, claim 55, drawn to a turbo charger device.

Group V, claim 56, drawn to a hydraulic piston pump or a hydraulic piston motor.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

an assessment of the prior art with respect to the independent claims provides no unity of invention since the "special technical features", i.e., "a sintered compact, wherein said sintered compact contains ... a residual made of Mo" common in each of the independent claims is known from Bonneau et al., 6,576,037. Applicant should note that the lack of unity is based on *A posteriori* and the special technical features, common to all inventions, do not define a contribution over the prior. See MPEP 1850.

Further, this application contains claims directed to more than one species of the generic inventions of the sliding member (II) and the connecting device (III). These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species of the sliding member are as follows:

Note that there are no specifics to the sliding members to be distinguished from each other. However, it seems that patentability is based on the material used for the sintered compact. Accordingly, the species restriction is based on the material of the sintered compact.

Sliding member

Ila. (sliding member containing sintered compact containing Cu or Cu alloy in an amount of 10 to 95 wt% and a residual made of Mo principally, said sintered compact having a relative density of 80% or more).

Ilb. (a mixed powder of bronze alloy, containing Sn of 5 to 20 wt%, in a content of 10 to 95 w% and a residual made of Mo principally).

Ilc. (a sintered layer is made such that a bronze based, lead bronze based, a Fe-Cu-Sn based or a Fe-Cu-Sn-Pb based sintered material is sintering-bonded to said steel back metal).

Ild. (a porous sintered compact consisting of Cu in an amount of 10wt% or less and having a porosity of 10 to 40% by volume containing a low-melting metal made of one or more elements selected from the group consisting of Pb, Sn, Bi, Zn, and Sb).

Ile. (a bronze alloy-Mo based sintered compact composed of bronze alloy phase containing Mo of 5 to 75wt% and Sn of 5 to 20wt%).

IIf. (a bronze alloy-Mo based sintered compact formed such that Mo powder compact is sintered simultaneously with being infiltrated with a bronze alloy based infiltrant).

Connecting device

IIIa. (sliding member containing sintered compact containing Cu or Cu alloy in an amount of 10 to 95 wt% and a residual made of Mo principally, said sintered compact having a relative density of 80% or more).

IIIb. (bushing is made of Fe-C-Cu based or Cu-Sn based oil retaining sintered material).

Applicant is required, in reply to this action, to elect a single species of the sliding member or the connecting device to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Claims 6-12, 53, and 54 correspond to species IIa.  
Claims 13-16 and 46 correspond to species IIb.  
Claims 17-20 corresponds to species IIc.  
Claims 29-34, 41, 44, 45, and 52 corresponds to species IIId.  
Claims 35, 36, 39, 40, 42, 50, and 51 correspond to species IIIf.  
Claims 37, 38, 43, 48, and 49 correspond to species IIIf.

Claims 21 and 22 correspond to species IIIa.  
Claims 23-28 correspond to species IIIb.

The following claim(s) are generic: no claims are generic.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

an assessment of the prior art with respect to the independent claims provides no unity of invention since the "special technical features", i.e., "a sintered compact, wherein said sintered compact contains ... a residual made of Mo" common in each of the species is known from Bonneau et al., 6,576,037. Applicant should note that the lack of unity is based on *A posteriori* and the special technical features, common to all inventions, do not define a contribution over the prior. See MPEP 1850.

A telephone call was made to Michael S. Huppert on August 25, 2009 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-7083. The examiner can normally be reached from 9:30AM-6:00PM. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Victor MacArthur/  
Primary Examiner, Art Unit 3679

/E. G./  
Examiner, Art Unit 3679  
September 3, 2009